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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,727	01/06/2006	James Pearce	09170.0001U1	1955
23859 7590 04/03/2009 Ballard Spahr Andrews & Ingersoll, LLP SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			EXAMINER SAMS, MATTHEW C	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,727

Applicant(s)

PEARCE ET AL.

Examiner

MATTHEW SAMS

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/6/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- _____ Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- _____ Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed on 2/3/2006 has been considered.

Drawings

3. The drawings filed on 1/6/2006 are accepted.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 16 is directed to "Computer software", which is considered a *program per se* and non-statutory. A tangible component that is encoded with a computer program can be considered statutory. If amended, the chosen language must be defined/fully supported in the specification in order to overcome this rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. The term "substantially" in claims 4, 20 and 33 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 5, 6, 11-15, 17-19, 21, 22 and 27-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Nicolas (US-2004/0252816).

Regarding claim 1, Nicolas teaches a method for profiling characteristics of a mobile device, the method comprising:

transmitting test data to the mobile device over a mobile communications network for output by the mobile device; (Page 1 [0020 & 0022])

providing query data to a user interface defining queries for display by the user interface, which queries concern the expected output of the test data by the mobile phone; (Page 1 [0021])

receiving response data from the user interface defining a response to the query; (Page 1 [0021] and Page 2 [0034]) and

storing the response data in a database. (Page 1 [0021], Page 3 [0041] and Pages 3-4 [0052])

Regarding claim 2, Nicolas teaches wherein the test data is transmitted to the mobile device using a dedicated data communications link. (Page 1 [0020] "when the telephone is activated and connected to the network" and "special programme to be downloaded beforehand")

Regarding claim 3, Nicolas teaches wherein the test data is transmitted to the mobile device using a data messaging service. (Page 2 [0031] "SMS")

Regarding claim 5, Nicolas teaches wherein respective queries concern respective items of test data. (Page 2 [0032-0033])

Regarding claim 6, Nicolas teaches that questions are presented with the corresponding answers for the survey (Page 2 [0029]) and that the questions inherently have an order when more than one question is being asked. (Page 2 [0034])

Regarding claim 11, Nicolas teaches wherein output of at least some items of test data comprises transmission of data over the mobile communications network. (Page 2 [0031] "sample survey data (DS) which can be downloaded by different means, such as SMS")

Regarding claim 12, Nicolas teaches wherein the response data comprises affirmative or negative responses to respective queries. (Page 1 [0021] "yes/no/do not know")

Regarding claim 13, Nicolas teaches wherein the response data comprises values for respective queries. (Page 1 [0021] "digit between 1 and 5 for example")

Regarding claim 14, Nicolas teaches wherein the response data comprises only affirmative responses, negative responses and values. (Page 1 [0021])

Regarding claim 15, Nicolas teaches a method of profiling the characteristics of plural mobile devices by carrying out the method of claim 1 for each of mobile device. (See citations above for claim 1 and Page 1 [0009-0011] and Page 2 [0027])

Regarding claim 17, Nicolas teaches an apparatus (Fig. 1 [IS]) for profiling characteristics of a mobile device, the apparatus comprising:

a network interface for transmitting test data to the mobile device over a mobile communications network for output by the mobile device; (Page 2 [0026])

a processor for providing query data to a user interface for display by the user interface (Page 2 [0026-0027]), which query data defines a query concerning the expected output of the test data by the mobile device (Page 2 [0027-0028]), and for receiving response data defining a response to the query from the user interface; (Page 1 [0021] and Page 2 [0034]) and

a database for storing the response data. (Page 1 [0021], Page 3 [0041] and Pages 3-4 [0052])

Regarding claim 18, the limitations of claim 18 are rejected as being the same reasons set forth above in claim 2.

Regarding claim 19, the limitations of claim 19 are rejected as being the same reasons set forth above in claim 3.

Regarding claim 21, the limitations of claim 21 are rejected as being the same reasons set forth above in claim 5.

Regarding claim 22, the limitations of claim 22 are rejected as being the same reasons set forth above in claim 6.

Regarding claim 27, the limitations of claim 27 are rejected as being the same reasons set forth above in claim 11.

Regarding claim 28, the limitations of claim 28 are rejected as being the same reasons set forth above in claim 12.

Regarding claim 29, the limitations of claim 29 are rejected as being the same reasons set forth above in claim 13.

Regarding claim 30, the limitations of claim 30 are rejected as being the same reasons set forth above in claim 14.

Regarding claim 31, the limitations of claim 31 are rejected as being the same reasons set forth above in claim 15.

Regarding claim 32, Nicolas teaches a computer server comprising the apparatus of claim 17. (Fig. 1 [IS & OP])

Regarding claim 33, Nicolas teaches a computer server for profiling the characteristics of a mobile device by providing a query page to a user interface at

substantially the same time as transmitting test data to the mobile device over a mobile communications network. (Page 3 [0046-0050])

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolas.

Regarding claim 4, Nicolas teaches the limitations of claim 1 above and that test data is transmitted to the mobile device and can be displayed on the user interface when an ideal time is determined. (Page 1 [0014]) Nicolas differs from the claimed invention by not explicitly reciting wherein the test data is transmitted to the mobile device substantially simultaneously to the query data being provided to the user interface. However, it is well within the scope of one of ordinary skill to recognize that the ideal moment for providing the query data to the user interface can be at the time of arrival of the test data since it enables an early warning to the survey institute as to whether a replacement for someone declining is warranted. (Page 2 [0028] and Pages 2-3 [0038-0039])

Regarding claim 20, the limitations of claim 20 are rejected as being the same reasons set forth above in claim 4.

11. Claims 7-10 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolas in view of Nakamura (US-5,943,617).

Regarding claim 7, Nicolas teaches the limitations of claim 1 above, but differs from the claimed invention by not explicitly reciting the respective items of test data test individual attributes of the mobile device.

In an analogous art, Nakamura teaches a radio channel test system for a mobile telecommunications network that includes items of test data test individual attributes of the mobile device. (Col. 2 lines 26-41) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have been motivated to implement the mobile phone surveying method of Nicolas after modifying it to incorporate the ability to test individual attributes of a mobile device of Nakamura since the testing of a wireless network utilizes the same basic principles of conducting surveys (polling a wide variety of customers/devices within the network and receiving feedback); with only the subject/reason of the survey differing.

Regarding claim 8, Nicolas in view of Nakamura teaches at least some items of test data test characteristics of the display of the mobile device. (Nakamura Col. 4 lines 55-65)

Regarding claim 9, Nicolas in view of Nakamura teaches output of at least some items of test data comprises display of the test data. (Nakamura Col. 2 lines 42-53)

Regarding claim 10, Nicolas in view of Nakamura teaches at least some of the items of test data test communication characteristics of the mobile device. (Nakamura Col. 7 lines 8-13)

Regarding claims 23-26, the limitations of claims 23-26 are rejected as being the same reasons set forth above respectively in claims 7-10.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW SAMS whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MATTHEW SAMS/
Examiner, Art Unit 2617

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617